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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,033

09/05/2003

Paul John Edwards

PC25402A

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04/22/2005

AGOURON PHARMACEUTICALS, INC.  
10350 NORTH TORREY PINES ROAD  
LA JOLLA, CA 92037

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/657,033

Applicant(s)

EDWARDS ET AL.

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 31.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 1-17 are pending in this application.

Claims 10-17 are drawn to non-elected invention.

### ***RESTRICTION REQUIREMENT***

IN response to the restriction requirement mailed 3/10/05, applicant elects group I, claims 1-9, wherein in formula 1, R0 is ethylene; R1 is phenyl substituted at position 4 by SOyR5; y is 2; R5 is methyl; R2 are H; R3 is ethyl and R4 is 3,5-dicyanophenyl. Applicant also elects Example 3, page 24 of the specification and HIV as utility. The election is made with traverse on the basis that groups V and VII should be rejoined. The Examiner is in total agreement with applicant. If the elected group I is found in condition for allowance, group V, claim 16 would be rejoined if within the scope of the allowable subject matter, and if the claimed utility in group VII, claims 14-15, have support in the specification by way of published journal or biological assay. Claims 14-16 must be free of any other 35 USC 112, first and second paragraph problems. The restriction is now made FINAL.

Claims 1-9 are being examined in part subject to the election made above by applicant.

### ***Status of Claims***

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the

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entire scope of the invention encompassing the elected compound as defined by common classification results in the following:

In formula 1, R1, R3 and R4 are as defined in claim 1; R0 is C1-C6 alkylene and R2 is H. As a result of the election and the corresponding scope of the invention identified above, the remaining subject matter of claims 1-9, are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the elected invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the elected invention, would not render obvious the non-elected subject matter.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "including" line 1, claim 2, is confusing. Is the composition comprising other active compounds in addition to a compound of formula I? If not, applicant should correct the claim by replacing the term with "of". Also, since claim 2 is written as independent claim the structure of formula I and definitions of the substituents thereof must be recited in the claim. A claim must stand alone to define the invention, and incorporation into the claims by reference to the specification or an external source is not permitted. Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

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Claims 4, 6, 8 are improperly depend from claim 2 for failure to further limit the scope of claim 2. For the same reason claims 5, 7, 9 are improperly depending from claim 3. All the claims are drawn to compositions but claims 4-9 recite intended use of the compositions. However, intended use is not a limitation of a compound or product. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). By deleting claims 4-9 the rejection would be overcome.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-9 are rejected under 35 U.S.C. 102(a) as being anticipated by Jones et al., WO 2002/085860.

Jones et al, disclose the instantly claimed compounds in generic formula 1, and the species. See the compounds in the attached abstract.

### ***Double Patenting Rejection***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 10/118,512, which is allowed.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim compounds having similar generic formulae and several same species are in the claims.

This is a provisional double patenting rejection since the conflicting claims are allowed and have not yet been patented.

#### ***Allowable Subject Matter***

Claims 1-9, would be allowed if the claims are amended within the scope of the elected invention as suggested above under Status of Claims, 2<sup>nd</sup> paragraph.

#### ***Rejoinder of Claims***

Claims 14-16 could not be rejoined because 14-15 recite "genetically-related retroviral infection" the viral of which is not disclosed in the specification and the variation between the viral not explained in the specification. Claim 16 is could not be rejoined because the claim is written in functional language and broader than the enabling disclosure in the specification for failure to recite with sufficient specificity how the reactions are performed. Instead the claim recites what is done. Also, claiming that all known alcohols have the same utility (applicable in the instant process) is not believable. The enumerated problems in claim 16 are examples only.

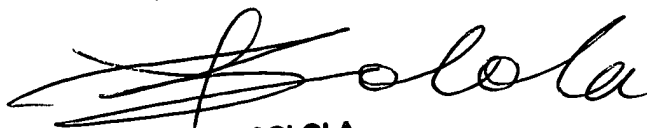
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***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Solola', with a stylized flourish above it.

**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

April 18, 2005